UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,669	10/15/2001	Jarmo Miettinen	2132-56PCON	3484

7590 03/25/2005

COHEN, PONTANI, LIEBERMAN & PAVANE
Suite 1210
551 Fifth Avenue
New York, NY 10176

EXAMINER	
HO, THOMAS M	

ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

HL

Office Action Summary	Application No.	Applicant(s)	
	09/977,669	MIETTINEN ET AL.	
	Examiner	Art Unit	
	Thomas M Ho	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *15 October 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☒ Claim(s) *1-13* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-13 are pending.

Claim Objections

2. Claims 1-13 are objected to as being sentence fragments. It has been the practice of the USPTO under MPEP 608.01(m) that every claim be a single sentence. Applicant's claims are currently sentence fragments. Correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6, 8, 9, 10 , 12 are rejected under 35 USC § 102(b) as being anticipated by Ohashi et al, US patent 5761309.

In reference to claim 1:

Ohashi et al. discloses a method for the management of certificates stored on an identity module, said method comprising:

Providing an identity module comprising a data processing device(where the identity module is the smart card and the smart card contains a central processing unit)(Column 5, lines 5-8), a storage device connected to said data processing device(where the storage device is the memory on the smart card)(Column 5, lines 5-8), a card certificate stored on the storage device(Column 6, lines 13-18), an application which uses the certificate stored on the identity module(Column 6, lines 35-40), and a data transfer device which is connected to said data processing device and which is provided with a communication interface for the transfer of information between an external device and the identity module(Figure 6, Item 11 "Card Reader/Writer")

- Receiving a certificate to the identity module, where the certificate is issued. (Column 6, lines 13-18)
- Authenticating said certificate by means of said card certificate, where the certificate is used in its authentication process. (Column 6, lines 17-25)
- Storing information obtained from said authenticated certificate on said storage device, where the certificate is stored. (Column 6, lines 13-18)

In reference to claim 2:

Ohashi et al. (Column 3, lines 34-37) discloses a method according to claim 1, further comprising filtering said authenticated certificate to remove a certification chain contained in said authenticated certificate, where a certification chain is the chain of authorities which were involved in distributing a certificate, and where this information can be filtered out of the certificate.

In reference to claim 3:

Ohashi et al. (Column 6, lines 18-25) discloses a method according to claim 1, wherein said certificate is authenticated by means of the card certificate before its use, where the certificate is authenticated prior to being used by the master authentication center in a later step.

In reference to claim 6:

Ohashi et al. (Column 6, lines 18-25) discloses a method according to claim 1, further comprising verifying whether said certificate is authentic before its use, and when authenticity cannot be verified, rejecting said certificate, where the certificate is used if it is determined to be valid.

Claim 8 is rejected for the same reasons as claim 1.

Claim 9 is rejected for the same reasons as claim 2.

Claim 10 is rejected for the same reasons as claim 3.

Claim 12 is rejected for the same reasons as claim 6.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 4, 5, 11, 7, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohashi et al.

In reference to claim 4:

Ohashi et al. discloses a method according to claim 1, wherein said stored information comprises a public key and an associated identity, where the associated identity is the user PIN. (Column 5, line 64 - Column 6, line 8)

The examiner takes official notice that putting a public key within a digital certificate was well known at the time of invention. In fact, a digital certificate is almost always comprised of user information and a public key that is digitally signed. While this may not always be the case, this is nevertheless the common understanding of the term. A definition is taken from the Wikipedia.

Public key certificate

From Wikipedia, the free encyclopedia.

(Redirected from Digital certificate)

In cryptography, a **public key certificate** (or **identity certificate**) is a certificate which uses a digital signature to bind together a public key with an identity — information such as a the name of a person or an organisation, their address, and so forth. The certificate can be used to verify that a public key belongs to an individual.

It would have been obvious to one of ordinary skill in the art at the time of invention to include within the stored certificate a public key since that is the common definition of the contents of a digital certificate.

In reference to claim 5:

Ohashi et al. fails to disclose a method according to claim 1, further comprising verifying whether said certificate is authentic prior to storage, and when authenticity cannot be verified, rejected said certificate.

Ohashi et al. (Column 6, lines 18-25) does disclose a method according to claim 1, further comprising verifying whether said certificate is authentic prior to usage after storage, and when authenticity cannot be verified, rejected said certificate.

It would have been obvious to one of ordinary skill in the art at the time of invention to verifying the certificate prior to storage in order to ensure the certificate being stored is authentic and avoid the wasting of storage space storing a certificate that was fraudulent.

In reference to claim 7:

Ohashi et al. fails to explicitly disclose a method according to claim 2, wherein the filtering comprises verifying whether each signature in said certificate is authentic, and filtering out only signatures that the verification proves to be authentic.

Ohashi et al. (Column 6, lines 15-23) discloses that the certificate are verified for authenticity.

A digital certificate as understood in the art to include a public key along with authentication information that is digitally signed. A digital signature is an encryption with a private key, the idea being that anyone(with the public key) should be able to read a digital signature, but only the signer should be able to create the signature. Thus digital certificates are verified by decrypting the digital signature.

The Examiner takes official notice that validating a certificate by checking if the signature itself is authentic and filtering out the signatures that are not verified was well known at the time of invention, where the filtering of a signature is if the digital signature is fraudulent.

It would have been obvious to one of ordinary skill in the art at the time of invention to check the digital signature itself of the digital certificate, and or consider or "filter" a signature that did not pass the steps of authentication as part of the process to verify the digital certificate.

Claim 11 is rejected for the same reasons as claim 5.

Claim 13 is rejected for the same reasons as claim 7.

Conclusion

7. The following art not relied upon is made of record.

- US patent 5,629,980 discloses a method of content distribution that uses an advanced digital license/certificate containing various user information.
- US patent 4868877 discloses digital certificates and their contents thereof.
- US patent 6101477 discloses a smartcard with a smartcard certificate.

8. Any inquiry concerning this communication from the examiner should be directed to Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory A. Morse can be reached on (571)272-3838.

The Examiner may also be reached through email through Thomas.Ho6@uspto.gov

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-2100.

General Information/Receptionist	Telephone: 571-272-2100	Fax: 703-872-9306
Customer Service Representative	Telephone: 571-272-2100	Fax: 703-872-9306

TMH

March 19th, 2005

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100